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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,046	05/10/2006	Richard Hendrickus Brinkhuis	00307.0043.PC/US00	5764
23369 7590 03/16/2010 HOWREY LLP-HN C/O IP DOCKETING DEPARTMENT 2941 FAIRVIEW PARK DRIVE, SUITE 200 FALLS CHURCH, VA 22042-7195				
EXAMINER NGUYEN, HAIDUNG D				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
03/16/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/564,046

**Applicant(s)**

BRINKHUIS ET AL.

**Examiner**

Haidung D. Nguyen

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-11 and 13-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-11, 13-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is responsive to applicant's amendment filed 11/9/09.

Claims 8-11, 13-24 are currently pending.

The previous rejection under 35 U.S.C. 112, second paragraph is withdrawn in view of applicant's amendment.

The previous anticipation rejection under 35 U.S.C. 102(b) over Kurosaki (JP 2000-226442) is maintained.

The previous obviousness rejection under 35 U.S.C. 102(b) over Buter (4,311,622) in view of Kurosaki (JP 2000-226442) is maintained.

The previous obviousness rejection under 35 U.S.C. 102(b) over Buter (4,311,622) in view of Kurosaki (JP 2000-226442) and Flosbach (6,815,501) is maintained.

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive.

With regard to the traversal of restriction of claim 12, it is noted that claim 1 recites a rheology modification agent obtainable either by reacting one or more polyisocyanates ... with one or more optically active carbon-substituted methylamines of the formula (I) not as racemic mixture, or by reacting one or more polyamines ... with one or more optically active monoisocyanates of the formula (II) not as racemic mixture, not both reactions, either one can be selected for prosecution. Since the former was selected for prosecution, the latter and its dependents were withdrawn from consideration. Claim 12 remains withdrawn from prosecution.

With regard to the objection of claim 14, it appears a misunderstanding exists. The Examiner did not object to claim 14, but rather rejected claim 13 for using "preferably" language. However, the rejection is withdrawn in view of applicant's amendment.

With regard to the rejection over Kurosaki, applicant argues that the reference does not teach or suggest a rheology modification agent. However, Kurosaki discloses the product obtained by the chemical reaction as set forth in claim 8 (see the abstract, para 0006 and 0007), it appears that this reaction product would have inherently exhibited rheology modification properties because all the material/chemical limitations of the instant invention have been satisfied. In light of this, it has been found that, products of identical chemical composition can not have mutually exclusive properties and a chemical composition and its properties are inseparable. See *In re Spada*, 911 F.2d 705,709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Kurosaki is silent on the amine being optically active and reaction product being a non-racemic; however, when the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112- 2112.02.

With regard to the rejection over Buter in view of Kurosaki, applicant argues that the examiner has failed to show some suggestion or motivation to modify or combine the reference teachings. However, Buter discloses a rheology modification agent (sag

control agent -abstract) obtained by reacting one or more polyisocyanates (col 1, In 36-57) with one or more methylamine such as .alpha.-methylbutylamine, and .gamma.-methylbutylamine (col 1, In 60-66). Buter does not disclose the monoamine being one or more optically active carbon-substituted methylamines of formula I, wherein the amine of formula I is not an optically active amino acid and not an optically active amino acid ester. In a similar invention, Kurosaki et al discloses a reaction product of one or more polyisocyanates (para 0006) with a methylamine (methylbenzyl amine - para0007) for improve temperature sensitive in adhesive compositions. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed methylbenzyl amine taught by Kurosaki in the theology modification agent of Buter as an equivalent alternative methylamine, for improving the temperature sensitive in laminations and adhesives (para 0025).

Furthermore, claim 8 recites a product-by-process. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product.

The rejection of claims 8-11, 13-24 are maintained for the reasons of records.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Examiner Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haidung D. Nguyen whose telephone number is (571)270-5455. The examiner can normally be reached on M-Th: 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

\HN\  
Haidung D Nguyen  
Examiner  
Art Unit 1796

3/11/2010

/DOUGLAS MC GINTY/

Primary Examiner, Art Unit 1796